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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/942,977	08/30/2001	Ken Kutaragi	100809-16280 (SCEW 18.970	7679
26304	7590	11/07/2006	EXAMINER	
KATTEN MUCHIN ROSENMAN LLP 575 MADISON AVENUE NEW YORK, NY 10022-2585			HENEGHAN, MATTHEW E	
			ART UNIT	PAPER NUMBER
			2134	

DATE MAILED: 11/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<p style="text-align: center;"><b>Office Action Summary</b></p>	<p>Application No.</p> <p>09/942,977</p>	<p>Applicant(s)</p> <p>KUTARAGI ET AL.</p>	
	<p>Examiner</p> <p>Matthew Heneghan</p>	<p>Art Unit</p> <p>2134</p>	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 June 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,3-5,18 and 19 is/are allowed.
- 6) ☒ Claim(s) 6-17 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 23 June 2006 has been entered.
2. In response to the previous office action, Applicant has amended claims 1 and 11. Claims 1 and 3-20 have been examined.
3. Examination of the instant application has been re-assigned to Examiner Matthew E. Heneghan, whose contact information is below.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 6-15, 17, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Ginter et al., hereafter Ginter (US Patent Number 5,892,900).

Regarding claim 6, Ginter teaches a computer system for monitoring utilization condition of contents, wherein said computer system is provided on a network on which a user terminal is allowed to connect, comprising a program that yields:

equipping information gathering means on the network (VDE on client processes contents usage metering information and connects to server on the network; column 11, lines 36-56, and column 17, line 56, through column 18, line 5);

registering authentication information on a database (col. 160, lines 52-64; col. 163, lines 38-66; col. 165, lines 55-64; col. 166, lines 31-34; col. 208, lines 8-16; col. 210, line 49-col. 211, line 2; col. 212, line 1-16);

embedding digital information in said contents, said digital information causing said user terminal to automatically transmit a contents utilizing history indicating a utilizing condition of the contents to said information gathering means at a predetermined timing (embedding digital information in contents via container; col. 134, line 67-col. 135, line 1; col. 134, lines 15-28; col. 135, lines 35-58; VDE on client monitors content usage and reports usage history to server periodically; column 18, lines 1-6; column 18, lines 22-24; column 33, lines 36-65; column 36, lines 10-43; column 137, lines 7-9; and column 141, lines 35-56);

distributing digital information embedded in said contents to said user terminal, wherein said user terminal includes a memory medium in which authentication information is included, and wherein said terminal is authenticated by said authentication information in the memory medium (col. 17, lines 42-48, col. 18, lines 6-21; col. 210, line 49-col. 211, line 2; col. 216, lines 54-58; col. 220, lines 1-58; col. 221, lines 18-22; col. 233, lines 36-37; col. 234, lines 29-32);

gathering, according to the digital information included in the distributed contents, said contents utilizing history via said information gathering means which is automatically transmitted from the user terminal (col. 23, lines 37-44; col. 33, lines 36-65; col. 168, lines 1-15; col. 176, lines 58-65; col. 188, lines 29-38);

recording the gathered contents utilizing history, in correspondence with said registered authentication information, in the database (col. 23, lines 37-44; col. 33, lines 36-65; col. 168, lines 1-15; col. 176, lines 58-65; col. 188, lines 29-38); and

creating utilizing information indicating how much the particular content is utilized based on said contents utilizing history collected through said information gathering means (col. 35, lines 13-53; col. 55, lines 44-51; col. 150, line 44-col.151, line 36).

Regarding claims 7, 9, and 10, Ginter further teaches the step of authenticating whether said user terminal and said contents utilized in said user terminal are proper or not, based on registered history data of transaction indicating that said contents are properly transacted and also based on registered user terminal identification data for

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authentication (column 11, lines 58-61; column 12, lines 31-37; column 21, lines 48-59; column 28, lines 17-42; and column 35, lines 13-53).

Ginter further teaches that said recording medium is loaded by recording said user terminal identification data to said data recording area of the recording medium and distributing said history data of transaction along with said contents (client network ID and site ID identify client terminal; column 25, lines 28-35; column 131, lines 28-61; and column 150, lines 49-52).

Ginter further teaches that said user terminal transmits said contents utilizing history to said information gathering means on condition that the number of times of utilizing the same content by the same user exceeds a predetermined number (budget sets limit on number of times user can utilize the same content; column 21, lines 48-59; column 28, lines 17-42; column 35, lines 13-53; column 59, lines 55-61; column 150, lines 44-52; and column 154, lines 34-37).

Regarding claim 8, the content may be encrypted and distributed with its associated control information (i.e. keys) (see column 13, lines 50-67).

Regarding claims 11-14, this claim constitutes a computer-system-including-computer-program version yielding the invention of claim 6 et al. Therefore, for the reasons applied above, such a claim also is anticipated.

Regarding claim 15, this claim constitutes a recording medium version of the invention of claim 6. Therefore, for the reasons applied above, such a claim also is anticipated.

Regarding claim 17, this claim constitutes a recording medium version of the claimed method steps above (claim 3), wherein all claim limitations have been addressed as set forth above. Therefore, for the reasons applied above, such a claim also is anticipated.

Regarding claim 20, Ginter discloses a media connector mechanism (network or disk cabling is inherent) and uses a removable memory medium such as a floppy disk drive (see column 62, line 64 to column 63, line 12).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter.

Ginter teaches all the limitations of claim 15, and further teaches that a transaction history data recording area for recording transaction history data, indicating that said contents are properly transacted (column 18, lines 6-21; column 33, lines 36-65; column 35, lines 13-53; column 40, line 62, through column 4, line 3). But Ginter does not explain that the transaction history recording area is provided at a position accessible by said user terminal prior to at least said contents recording area.

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However, Ginter teaches that the transaction history data recording area and the contents recording area exist on the same recording medium (column 17, lines 42-48). Arbitrarily, the former will occur either prior to or succeeding from the latter. Absent a showing of criticality as to the particular position of the transaction history data recording area in respect to the contents recording area, one of ordinary skill in the computer art at the time the invention was made would select the positioning the former prior to the latter with equal probability to its contravening format; therefore, the claim would have been obvious.

***Allowable Subject Matter***

6. Claims 1, 3-5, 18, and 19 are allowed.

7. The following is a statement of reasons for the indication of allowable subject matter:

Regarding claim 1, though Ginter discloses the embedding of digital information in content leading to the transmission of utilization history, Ginter does not disclose the incorporating of digital information, such as a computer program, that itself causes the transmission. No other art would suggest incorporating the transmission of utilization histories in a program in digital content.

Claims 3-5, 18 and 19 are allowable based upon their dependence upon base claim 1.



### ***Response to Arguments***

8. Regarding arguments that Ginter does not disclose that the digital information does not cause the transmission of utilization history, Ginter's discloses the periodic transmission of history information; this does not occur if the digital information is not in use; therefore, the presence of the digital information causes the periodic transmissions. In amended claim 1, on the other hand, the transmission is being directly actuated by the digital information, and this is not being done by Ginter.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew E. Heneghan, whose telephone number is (571) 272-3834. The examiner can normally be reached on Monday-Friday from 8:30 AM - 4:30 PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jacques Louis-Jacques, can be reached at (571) 272-6962.

**Any response to this action should be mailed to:**  
Commissioner of Patents and Trademarks

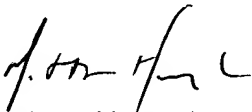
P.O. Box 1450  
Alexandria, VA 22313-1450  
**Or faxed to:**  
(571) 273-3800

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MEH

September 1, 2006

  
Matthew Heneghan, USPTO Art Unit 2134